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10/06/2003

Geoffrey Flagstad

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EXAMINER

TOMASZEWSKI, MICHAEL

ART UNIT

PAPER NUMBER

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/679,749

Applicant(s)

FLAGSTAD, GEOFFREY

Examiner

Mike Tomaszewski

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the amendment filed on 11/13/06. Claims 3-4 have been cancelled and claims 19, 25, and 30 have been amended. Claims 1-2 and 5-64 are pending.

Examiner acknowledges the discrepancy pointed out by Applicant regarding whether the previous Office Action filed on 8/11/06 was intended to be a final action or a non-final action. For clarification, Examiner intended the previous Office Action filed on 8/11/06 to be a non-final office action. As such, Examiner will proceed accordingly.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-2, 5-8, 11-32, 35-46, and 49-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal (US 2001/0041991; hereinafter Segal), in view of Joao (6,283,761; hereinafter Joao), and in view of Official Notice.

(A) As per previously presented claim 1, Segal discloses a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

- (1) inducing said patient to receive said medical record from a covered entity (Segal: pg. 2, par. [0014]; pg. 12, par. [0151]) (Examiner notes Segal teaches that the patient has ownership and control of their medical records. As such, other parties interested in acquiring a medical record from a patient would be required to induce the patient to obtain their medical records for them.);
- (2) receiving said medical record from said patient in a storage format, without data processing said medical record (Segal: pg. 12, par. [0012]); and
- (3) storing said medical record in a memory in a form from which said medical record can be reproduced in said storage format (Segal: pg. 12, par. [0012]).

Segal, however, fails to *expressly* disclose a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

- (4) storing said medical record *without data processing said medical record* [Emphasis added];
- (5) obtaining agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions; and
- (6) transmitting said medical record to a third party when the defined conditions occur, without data processing said medical record.

Nevertheless, these features are old and well known in the art, as evidenced by Joao and Official Notice. In particular, Joao and Official Notice disclose a method for a service provider to obtain a medical record of a patient from a covered entity in a form allowing said service provider to quickly disclose said medical record to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996, the

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method comprising the following steps carried out by a service provider that is not the patient or a covered entity:

- (4) storing said medical record *without data processing said medical record* (Joao: col. 2, lines 26-30; col. 3, lines 25-45; col. 4, lines 27-33; col. 6, lines 52-56);
- (5) obtaining agreement in advance with the patient that the service provider shall transmit said medical record to a third party under defined conditions (Official Notice: Examiner takes Official Notice that the technique of having one party (e.g., intermediary, middle man, straw man, *etc.*) perform certain actions on behalf of another party through an agreement is notoriously well known and obvious. For example, a power of attorney, a proxy agreement, and executor/trustee agreements, are commonly used to obtain an agreement in advance between multiple parties to consummate an agreed course of action (e.g., transmission of medical records, *etc.*). Moreover, these techniques were developed and used prior to Applicant's invention to facilitate transactions.); and
- (6) transmitting said medical record to a third party when the defined conditions occur, without data processing said medical record (Official Notice: See step (5) above.).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Segal and Official Notice with the motivation of providing healthcare information to pertinent parties (Joao: col. 7, lines 61-65).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Official Notice with the combined teachings of Segal and Joao with the motivation of facilitating transactions.

(B) As per previously presented claim 2, Segal discloses the method of claim 1, further comprising:

said service provider inducing said patient to obtain possession of said medical record from said covered entity in a first format and said service provider inducing said patient to convert said medical record to said storage format, wherein said storage format is different from said first format (Segal: pg. 3, par. [0027]) Examiner notes Segal teaches a patient, "with guidance from their physician," obtaining their medical record in a first format (i.e., hard copy) and converting said medical record into a storage format (i.e., digital format via computer data entry).

(C) As per original claim 5, Segal discloses the method of claim 1, wherein:
said memory is a portable medium (Segal: pg. 12, par. [0151]).

(D) As per original claim 6, Segal discloses the method of claim 5, wherein:

said portable medium is an optical disc (Segal: pg. 12, par. [0151]).

(E) As per original claim 7, Segal discloses the method of claim 1, further comprising:

retrieving said medical record stored in said memory remotely through a computer communications network (Segal: Fig. 1).

(F) As per previously presented claim 8, Segal discloses the method of claim 1, further comprising:

said service provider inducing said patient to update said medical record stored in said memory (Segal: pg. 12, par. [0151]).

(G) As per original claim 11, Segal discloses the method of claim 1, wherein:
said medical record is stored in a hierarchical storage system (Segal: Fig. 2a).

(H) As per original claim 12, Segal discloses the method of claim 11, wherein:
said medical record is assigned to at least one file folder, said file folder containing medical records sharing at least one common attribute (Segal: Fig. 2a).

(I) As per original claim 13, Segal discloses the method of claim 12, wherein:
said file folder is assigned to at least one file template, said file template containing file folders sharing at least one common attribute (Segal: Fig. 2a).

(J) As per original claim 14, Segal discloses the method of claim 13, wherein:
a plurality of said file templates are stored in said storage system to form a general medical and personal information file of said patient (Segal: pg. 3, par. [0027]; Fig. 2a).

(K) As per original claim 15, Segal discloses the method of claim 12, wherein:
said file folder further comprises at least one sub-folder (Segal: Fig. 2a).

(L) As per original claim 16, Segal discloses the method of claim 11, wherein:
said hierarchical storage system provides hierarchical storage access (Segal: pg. 9, par. [0012]). Examiner notes also that, as a standard feature, data storage and operating systems (e.g., Microsoft Windows) enable a user to define multi-level access parameters to user designated files, folders, drives, databases, and/or applications, among other items.

(M) As per original claim 17, Segal discloses the method of claim 14, wherein:
access to a special file template is on a different basis than access to at least one other file template (Segal: pg. 9, par. [0012]). Examiner notes also that, as a standard feature, data storage and operating systems (e.g., Microsoft Windows) enable a user to define multi-level access parameters to user designated files, folders, drives, databases, and/or applications, among other items.

- (N) As per original claim 18, Segal discloses the method of claim 7, wherein:
said special file template is an emergency file template (Segal: Fig. 2a).
- (O) As per original claim 22, Segal discloses the method of claim 20, wherein:
said system is provided in the form of software (Segal: pg. 3, par. [0022]).
- (P) Claims 19-21 and 23-29 substantially repeat the same limitations of claims 1, 2, 5-11 and 16, and therefore, are rejected for the same reasons given for those claims and incorporated herein.
- (Q) Currently amended claim 30 substantially repeats the same limitations as amended claims 1 and 2 and therefore, is rejected for the same reasons given for those claims and incorporated herein.
- (R) As per original claim 32, Segal discloses the system of claim 30, wherein:
said communication interface is adapted for acquiring said medical record from said patient in said storage format (Segal: pg. 7, par. [0099]; pg. 12, par. [0146]; Fig. 1 and Fig. 4).
- (S) As per original claim 46, Segal discloses the system of claim 44, wherein:

said special file template is stored in a first memory and said general medical information file is stored in a second memory wherein said first and second memories are different optical discs (Segal: pg. 4, par. [0030]; Fig. 1).

(T) Claims 31, 35-45 and 47-49 substantially repeat the same limitations of claims 3-7, 8-18 and 20, and therefore, are rejected for the same reasons given for those claims and incorporated herein.

(U) As per previously presented claim 50, Segal discloses the method of claim 1, wherein said medical record is made by the covered entity before said inducing (Segal: par. [0121]).

(V) As previously presented claim 51, Segal discloses the method of claim 1, wherein said inducing occurs before the patient obtains possession of the medical record (Segal: par. [0024], [0027] and [0121]).

(W) As per previously presented claim 52, Segal discloses the method of claim 1, wherein the patient obtains possession of the medical record before said acquiring (Segal: par. [0121]).

(X) As per previously presented claim 53, Segal discloses the method of claim 1, wherein the patient has a computer with Internet access, and said inducing further

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comprises said service provider inducing said patient to obtain possession in said patient's computer of said medical record in digital form from a covered entity (Segal: par. [0024], [0026], [0027] and [0108], fig. 1).

(Y) As per previously presented claim 54, Segal discloses the method of claim 1, further comprising said service provider inducing said patient to acquire said medical record in a digital storage format without intervention of any entity or person other than said covered entity (Segal: Segal: par. [0024], [0026], [0027] and [0108], fig. 1).

(Z) Claims 55-64 substantially repeat the same limitations as those recited in claims 50-54 and therefore, are rejected for the same reasons given for those claims and incorporated herein.

4. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal, Joao, and Official Notice, as applied to claim 1 above, and further in view of Judson et al. (US 2005/0026117; hereinafter Judson).

(A) As per original claim 33, Segal discloses system of claim 30, wherein:

said communication interface is adapted to obtain the agreement of said patient to allow transmission of said medical record to a health care provider (Segal: pg. 3, par. [0028]).

Segal, however, fails to *expressly* disclose the system of claim 30, wherein:

under defined conditions.

Nevertheless, this feature is old and well known in the art, as evidenced by Judson. In particular, Judson discloses the method of claim 1, further comprising:

under defined conditions (Judson: pg. 8, par. [0105]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Judson within the combined teachings of Segal, Joao, and Official Notice with the motivation of managing a user's (e.g., patient) medical data (e.g., genomic data) (Judson: pg. 1, par. [0010]).

(B) As per original claim 34, Segal fails to *expressly* disclose the system of claim 30, wherein:

communication interface is adapted to obtain said agreement before a defined condition arises.

Nevertheless, this feature is old and well known in the art, as evidenced by Judson. In particular, Judson discloses the method of claim 3, further comprising:

said agreement is obtained before a defined condition arises (Judson: pg. 8, par. [0105]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Judson with the combined teachings of Segal, Joao, and Official Notice with the motivation of managing a user's (e.g., patient) medical data (e.g., genomic data) and decreasing unauthorized access to medical data (Judson: pg. 1, par. [0010] and pg. 8, par. [0105]).

5. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segal, Joao, and Official Notice, as applied to claim 1 above, and further in view of Mok et al. (US 2003/0140044; hereinafter Mok).

(A) As per previously presented claim 9, Segal fails to *expressly* disclose the method of claim 1, further comprising:

said service provider inducing said patient to provide other information that is not a medical record, and storing said other information in said memory.

Nevertheless, this feature is old and well known in the art, as evidenced by Mok. In particular, Mok discloses the method of claim 1, further comprising:

said service provider inducing said patient to provide other information that is not a medical record, and storing said other information in said memory (Mok: pg. 14, par. [0127]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Mok with the combined teachings of Segal, Joao, and Official

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Notice with the motivation of including other types of records where a person needs his/her records collected (Mok: pg. 14, par. [0127]).

(B) As per original claim 10, Segal fails to *expressly* disclose the method of claim 9, wherein:

said other information comprises information selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement.

Nevertheless, this feature is old and well known in the art, as evidenced by Mok. In particular, Mok discloses the method of Claim 9, wherein:

said other information comprises information selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement (Mok: pg. 14, par. [0127]) (The Examiner has noted insofar as claim 10 recites "selected from the group consisting of a living will, investment portfolio, life insurance and a credit arrangement," an investment portfolio has been recited.).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Mok with the combined teachings of Segal, Joao, and Official Notice with the motivation of including other types of records where a person needs his/her records collected (Mok: pg. 14, par. [0127]).

Response to Arguments

6. Applicant's arguments filed 11/13/06 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 11/13/06.

(A) On pages 13-16 of the 11/13/06 response, Applicant argues that the Joao reference does not disclose a method allowing a service provider, who is not the patient or a covered entity, to quickly disclose the medical record of a patient to a third party without restriction by the Health Insurance Portability and Accountability Act of 1996 (HIPAA). More specifically, Applicant argues that the method wherein the service provider stores the medical record without data processing the medical record is not taught or suggested by the Joao reference.

In response, Examiner respectfully submits that a broad, yet reasonable interpretation, of Joao does indeed teach the aforementioned features of Applicant's claimed invention.

For example, Joao teaches the following:

(i)

The present invention provides an apparatus and methods **for providing** healthcare information and/or healthcare-related information which overcomes the shortcomings of the prior art [Emphasis added]. See Joao: col. 2, lines 26-30.

(ii)

The apparatus also includes an intermediary communication device or computer which is associated with an intermediary, a broker, an agent, and/or any other individual and/or entity, that can utilize the present invention **in order to act for and/or on behalf of any other individual, party, or entity, described herein**. The intermediary computer(s) **can** communicate with, and operate in conjunction with, central processing computer systems described herein [Emphasis added]. See Joao: col. 3, lines 26-33.

(iii)

Each of the central processing computer(s), the provider computer(s), the payer computer(s), the patient computer(s), and/or the intermediary computer(s), **can** transmit information to, as well as receive information from, any of the computers described herein. In this regard, each of the computers **can** communicate with, process information from, **and/or** share data and/or information with, each other and/or any other computer or computers described herein and/or utilized in conjunction with the present invention. In this manner, data and/or **information transfer between any of the computers can take place in a bi-directional manner** [Emphasis added]. See Joao: col. 3, lines 34-45.

(iv)

The apparatus and method of the present invention can be utilized in **numerous preferred embodiments** in order to provide a vast array of healthcare and healthcare-related services for any one or more of the various parties described herein. **Any patient, user, provider, payer, and/or intermediary, may utilize the present invention in the same, similar and/or analogous manner** [Emphasis added]. See Joao: col. 4, lines 27-33.

First, Joao teaches, in passage excerpt (i), *supra*, that his invention provides an apparatus and methods for **“providing healthcare information”** without mentioning “data processing” [Emphasis added]. Although Joao does later teach that the present

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invention also provides an apparatus and a method for providing a comprehensive processing system," this feature (i.e., processing) is merely another embodiment.

Second, contrary to Applicant's arguments, Joao does not *exclusively* teach that "data processing" must occur, should occur, and/or is occurring. Rather, Joao teaches multiple embodiments including an embodiment where no "data processing" occurs, as evidenced by Joao's use of alternative language, such as "can" and "and/or," as emphasized in passage excerpts (i)-(iv), *supra*. In other words, a broad, yet reasonable, interpretation of these Joao passages teaches that "data processing" is optional.

Third, Joao teaches, in passage excerpt (i), *supra*, "Any patient, user, provider, payer, and/or intermediary, may utilize the present invention in the same, similar and/or analogous manner." Therefore, a broad, yet reasonable, interpretation of Joao, would include a teaching where a service provider, who is not the patient or a covered entity, may utilize the invention as if the service provider were a patient (i.e., a party who provides and/or stores a medical record with data processing).

In short, Examiner respectfully submits that Joao does indeed teach the aforementioned features of Applicant's claimed invention.

(B) On pages 16-17 of the 11/13/06 response, Applicant traverses Examiner's Official Notice and argues that it is not appropriate.

In response, Examiner notes that **in order to adequately traverse** such an Official Notice finding, an Applicant must specifically point out the supposed errors in

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the examiner's action, which would include **stating why the noticed fact is not considered to be common knowledge or well-known in the art** [Emphasis added].

See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").

Moreover, if Applicant does not traverse the Examiner's assertion of Official Notice or Applicant's traverse is not adequate, the Examiner should clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant either failed to traverse the Examiner's assertion of Official Notice or that the traverse was inadequate. If the traverse was inadequate, the Examiner should include an explanation as to why it was inadequate.

Accordingly, Examiner respectfully submits that Applicant's traverse of Official Notice was inadequate because Applicant did not state why the noticed fact is not considered to be common knowledge or well-known in the art. As such, the features rejected via Official Notice are deemed to be admitted prior art.

(C) Applicant's remaining arguments in the response filed 11/13/06 rely on or re-hash the issues addressed above and therefore, are moot in view of the responses given above and incorporated herein.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


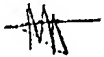
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT



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